



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,589	12/28/2000	Karl Guegler	CL000861	4832

25748 7590 03/22/2002

CELERA GENOMICS CORP.
ATTN: WAYNE MONTGOMERY, VICE PRES, INTEL PROPERTY
45 WEST GUDE DRIVE
C2-4#20
ROCKVILLE, MD 20850

EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 03/22/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,589

Applicant(s)

Guegler et al.

Examiner

John Ulm

Art Unit

1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1646

Claims 1 to 23 are pending in the instant application.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 20 and 21 drawn to an isolated peptide, classified in class 530, subclass 350.
- II. Claim 3, drawn to an antibody, classified in class 530, subclass 388.22.
- III. Claims 4, 5, 6, 8 to 11, 22 and 23, drawn to an isolated nucleic acid and method of use, classified in class 435, subclass 69.1.
- IV. Claim 7, drawn to a transgenic animal, classified in class 800, subclass 2.
- V. Claim 12, drawn to a method of detecting a protein in a sample, classified in class 435, subclass 7.2.
- VI. Claim 13, drawn to a method of detecting a nucleic acid in a sample, classified in class 435, subclass 6.
- VII. Claims 14 to 16, drawn to a binding assay, classified in class 436, subclass 501.
- VIII. Claim 17, drawn to a pharmaceutical composition comprising a compound of unspecified constitution, classification undeterminable.
- IX. Claim 18, drawn to a method of treatment by administering a compound of unspecified constitution, classification undeterminable.
- X. Claim 19, drawn to a method of determining the effect of a test compound on the expression of a gene or gene product, classified in class 435, subclass 4.

The inventions are distinct, each from the other because:

Art Unit: 1646

The peptide of invention I, the antibody of invention II, the animal of invention III, and the compound of invention VIII are four different compounds or compositions, each of which can be made and used without the others. Lack of unity is shown by the fact that these four different compositions lack a common utility which is based upon a common structural feature lacking from the prior art.

Inventions II and VIII are related to inventions V and X as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the detection method of invention V and the expression assay of invention X can be practiced with the antibody of invention II or a ligand for the protein of the instant invention, which is invention VIII, whose identity has yet to be determined and which is materially different from the antibody of invention II. Further, the method of invention X can be practiced with a nucleic acid of invention III since measuring the expression of a polypeptide can be done by measuring the concentration of the polypeptide of interest or by measuring the concentration of mRNA encoding that polypeptide.

Inventions III and VI are also related as product and process of use. They are shown to be distinct because the nucleic acid on invention III can be used to produce the protein encoded thereby, which is a process that is materially different from the detection method of invention VI.

Art Unit: 1646

Inventions I and III are each related to invention VII as product and process of use. They are shown to be distinct because the binding assay of invention VII, as claimed, can be practiced with the isolated peptide of invention I or a recombinant cell of invention III, which are two materially different products..

Inventions VIII and IX are related as product and process of use. They are shown to be distinct because the compound of invention VIII can be used to detect the protein of invention I in a sample.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

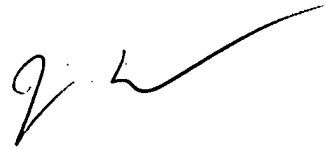
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

Art Unit: 1646

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM
PRIMARY EXAMINER
GROUP 1800